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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,015	03/25/2004	Tommy Constantine	4089-A3C	7839

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EXAMINER	
NGUYEN, KIMBERLY D	

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/809,015	CONSTANTINE, TOMMY	
	Examiner	Art Unit	
	Kimberly D. Nguyen	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 21-28 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 21-28 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Amendment

1. Acknowledgment is made of Preliminary Amendments filed March 25, 2004 and December 10, 2004.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ormum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 21-28 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,739,506. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is a broader recitation of patent '506. For example, in claim 1 of the present invention and claim 1 of patent '506, the applicant claims:

"A method comprising steps of: providing an authorized user of a credit card issued by a service provider;" whereas in the patent '506, the applicant claims "A method comprising steps of: providing an authorized user of a credit card issued by a service provider;" (col. 9, lines 44-46)

"the authorized user incurring debt on the credit card;" whereas in the patent '506, the applicant claims "the authorized user incurring debt on the credit card;" (col. 9, line 59) and

"for a predetermined amount of debt incurred by the authorized user on the credit card, the service provider submitting an entry into a sweepstakes on behalf of the authorized user." whereas in the patent '506, the applicant claims "for a predetermined amount of debt incurred by the authorized user on the credit card, the service provider submitting an entry into a sweepstakes on behalf of the authorized user." (col. 9, lines 60-63)

Thus, as discussed above, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teachings of patent '506 as a guideline teachings for a method comprising the steps as set forth in the claimed invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 21-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Yan et al. (US 2002/0152116; hereinafter "Yan").

Re claim 21: Yan teaches a method comprising steps of:

providing an authorized user of a credit card issued by a service provider ("...provide an authorized card holder of a credit card" paragraph 31, lines 1-3);

the authorized user incurring debt on the credit card ("...provide an authorized card holder of a credit card, who incurs debts on or with the card..." paragraph 31, lines 1-6); and

for a predetermined amount of debt incurred by the authorized user on the credit card, the service provider submitting an entry into a sweepstakes on behalf of the authorized user ("...provide an authorized card holder of a credit card, who incurs debts on or with the card, with an award (i.e. dynamically generated rebate, fixed rebate) that itself represents an opportunity, on the basis of the debts incurred with the credit card ... The second mode comprises awarding a deep sweepstake rebate wherein a transaction or an account is dynamically selected for a fixed discount percent as designated by the sponsoring card issuer..." paragraphs 31 and 30-32).

Re claim 22: Yan teaches the method further comprising conducting a drawing from entries of the sweepstakes, wherein the entry of the authorized user is one of the entries (paragraph 7).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yan in view of Shurling et al. (US 6,009,415; hereinafter "Shurling"). The teachings of Yan have been discussed above.

Yan fails to teach the steps of providing an authorized user of a credit card issued by a service provider; the authorized user referring a first/new customer to the service provider for credit card services; the first/new customer submitting/enrolling an application for credit card services to the service provider; the service provider receiving, processing and approving the application and issuing a credit card to the first customer establishing a first referred authorized user of a credit card; and in consideration therefore to the authorized user the service provider issuing valuable consideration to the authorized user.

Shurling teaches a method comprising steps of:

providing an authorized user (24 in fig. 1) of a credit card issued by a service provider (col. 1, lines 6-27; col. 4, lines 20-42);

the authorized user referring a first/new customer to the service provider for credit card services (col. 1, lines 6-27; col. 4, lines 20-42);

the first/new customer submitting/enrolling an application for credit card services to the service provider (col. 7, lines 48-65);

the service provider receiving, processing and approving the application and issuing a credit card to the first customer establishing a first referred authorized user of a credit card; and in consideration therefore to the authorized user the service provider issuing valuable consideration (i.e., Incentive Rewards) to the authorized user (abstract; col. 2, line 46 through col. 3, line 11; col. 4, lines 6-20).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the steps of referring new customer to the service provider as taught by Shurling to the teachings of Yan in order to apply/grant the sweepstake incentives (i.e., entering sweepstake entry) to the referring customer encouraging customer to refer new customer(s) to increase the chance to win.

8. Claims 24 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yan as modified by Shurling as applied to claim 23 above, and further in view of Selgas et al. (US 6,571,290; hereinafter "Selgas"). The teachings of Yan as modified by Shurling have been discussed above.

Although, Shurling teaches the step of the first/new customer submitting an application for credit card services to the service provider (col. 7, lines 48-65); and other customers which a specific customer may refer to the bank (col. 11, lines 41-45); Yan as modified by Shurling fails to teach or fairly suggest the first customer designating the authorized user as a referring party.

Selgas teaches the step of the user 110 enters registration information about the user 110 and Referral Information if available (col. 15, lines 58-65), which serves as the first customer designating the authorized user as a referring party.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the first customer designating the authorized user as a referring party as taught by Selgas to the teachings of Yan as modified by Shurling in order to provide a useful option for the new user to designate the referring party. Such modification would have been an obvious expedient to an artisan of ordinary skill in the art in order to provide a way for new user to designate the referring party.

Conclusion

Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Nguyen whose telephone number is 571-272-2402. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KDN
February 18, 2006